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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JIAPING SONG

Appeal 2008-0965
Application 10/092,199
Technology Center 2600

Decided: November 14, 2008

Before ROBERT E. NAPPI, JOHN A. JEFFERY, and KARL D.
EASTHOM, *Administrative Patent Judges*.

NAPPI, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 6(b) of the final rejection of claims 1, 3 through 11, and 13 through 18.

We reverse the Examiner's rejections of these claims.

INVENTION

The invention is directed towards a method for use with a photographic printer. The printer's front panel presents information from

the image and allows the user to edit the image to add a time. See pages 2 and 3 of Appellant's Specification. Claim 1 is representative of the invention and reproduced below:

1. A method for using a printer to interpret time stamp information from a digital camera, the method comprising:
receiving image information from a digital camera in a first format with corresponding time stamp information at a printer interface;
converting the image information and time stamp information to bitmap information;
at a printer front panel, displaying the images with corresponding time stamps for editing;
in response to the editing, embedding time stamp bitmap information in the image bitmap information; and,
supplying the edited images with corresponding time stamps to a print engine for printing.

REFERENCES

Kobori	US 5,028,993	Jul. 2, 1991
Shiota	US 6,185,000 B1	Feb. 6, 2001
Kakigi	US 2002/0054350 A1	May, 9, 2002 (filed Jul. 20, 2001)

REJECTION AT ISSUE

The Examiner has rejected claims 4 and 10 under 35 U.S.C. § 112 second paragraph. The Examiner's rejection is on pages 4 and 5 of the Answer¹.

The Examiner has rejected claims 1, 3 through 7, 10, 11, and 13 through 16 under 35 U.S.C. § 103(a) as being unpatentable over Kakigi in

¹ Throughout the opinion we refer to the Answer mailed June 14, 2007.

view of Shiota. The Examiner's rejection is on pages 5 through 6 of the Answer.

The Examiner has rejected claims 8, 9, 17, and 18 under 35 U.S.C. § 103(a) as being unpatentable over Kakigi in view of Shiota and Kobori. The Examiner's rejection is on pages 11 through 12 of the Answer.²

ISSUES

Rejections based upon 35 U.S.C. § 103(a)

Appellant argues on pages 9 of the Brief³, that the prior art does not teach or suggest a printer that embeds one bit map inside of another as claimed. Further, in response to the Examiner's finding that Kakigi teaches that the time stamp is inherently part of the image, Appellant asserts that this is not supported by the evidence and that the Examiner has not provided extrinsic evidence to show that the time stamp is necessarily embedded in the image file.

Thus, Appellant's contentions with respect to the rejections based upon 35 U.S.C. § 103(a) present us with the issue: did the Examiner err in finding that the combination of Kakigi and Shiota teaches that the time stamp is embedded in the image file as claimed?

² We note that the Answer does not mention claims 9, 17, and 18, but repeats the rationale used to reject claims 9, 17, and 18 on page 6 of the Final Rejection mailed February 28, 2008.

³ Throughout the opinion, we make reference to the Brief, received May 5, 2006 and the Reply Brief, received August 9, 2006.

Rejections based upon 35 U.S.C. § 112 second paragraph.

Appellant argues on pages 2 and 3 of the Reply Brief that the Examiner's rejection of claims 4 and 10 under 35 U.S.C. § 112 second paragraph is in error. Appellant asserts that the phrase "the print time stamp option" in claims 4 and 10 is sufficiently clear and one skilled in the art would understand that this limitation discusses presentation of the option, which permits a user to select a print time stamp. Reply Brief, 3. Further, Appellant argues that the phrase is clearer than if presented as "a print time stamp option." *Id.*

Thus, Appellant's contentions with respect to the Examiner's rejection under 35 U.S.C. § 112 second paragraph present us with the issue: did the Examiner err in determining that the phrase "the print time stamp" render claims 4 and 10 indefinite?

PRINCIPLES OF LAW

"To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.' 'Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (citations omitted).

The purpose of the definiteness requirement is to ensure that the claims delineate the scope of the invention using language that adequately notifies the public of the patentee's right to exclude. *Datamize, LLC v. Plumtree Software, Inc.*, 417 F.3d 1342, 1347 (Fed. Cir. 2005) (citing

Honeywell Int'l, Inc. v. Int'l Trade Comm'n, 341 F.3d 1332, 1338 (Fed. Cir. 2003)). A claim is sufficiently definite under 35 U.S.C. § 112, second paragraph, if a person skilled in the field of the invention would reasonably understand it when it is read in the context of the specification. *Marley Mouldings Ltd. v. Mikron Industries, Inc.*, 417 F.3d 1356, 1359 (Fed. Cir. 2005).

FINDINGS OF FACT

1. Kakigi teaches an image recording device where the user can select the paper output port/ tray of the printer. Abstract.
2. The user can select an “identification attribute” as an attribute of the image that is used to determine which paper output tray of the printer the printed photo is to be placed in. Kakigi, paras. 0156 and 0157.
3. The identification attribute can be: photographic date, title user format or other data. Kakigi, para. 0158.
4. The camera or the printer is used to set the output discharge mode, and the identification attribute. The information is stored along with the images on the memory card. Kakigi, paras. 0150 and 0175.
5. The data stored in the memory card has a data structure which includes an image forming instruction file 20 and image file 10. Kakigi, see Figure 4, paras. 0187 and 0188.
6. The image forming instruction file includes “image inherent information” - item 22 of Figure 5. This information contains, among other information, the date. This information also is used to prepare the print job. Kakigi paras. 0192, 0194, 0208, and 0212.

7. Kakigi teaches that the bitmap image is generated by the printing device using from the image data. Para. 0022.
8. Kakigi teaches that editing of the image may be performed. However, this is only discussed as being performed through interaction with the camera. Paras. 0122, 0425, and 0426.
9. Kakigi does not identify or discuss where or when the edits to the image data are made and whether they are made before or after the bitmap is created. Further, Kakigi does not teach that one of the editing features allows the date to be inserted into the image.
10. Shiota teaches a system where a user can edit a digital picture to add information and identify where the information should appear on the picture. Abstract.
11. Shiota teaches that the date a picture is taken is recorded on a memory card in a recording information file. Col. 3, ll. 45-53.
12. The memory card can then be put into a computer where the user selects whether they want the information (e.g. date of photograph) included on the print out of the image. The results of the user's selections are added to the recording information file. Shiota, col. 4, ll. 1-20
13. The memory card, or other medium, containing the image file and the information recording file, can then be forwarded to a development print enlargement (DPE) facility (a location where prints are made). The DPE uses the image information and the recording information to produce printouts. Shiota, col. 4, ll. 21-24.

14. Shiota does not disclose where the bitmap of the image is created and how the image and the date information are combined to produce the printout with the image and date.

ANALYSIS

Rejections based upon 35 U.S.C. § 103(a)

Appellant's contentions have persuaded us that the Examiner erred in finding that the combination of Kakigi and Shiota teaches that the time stamp is embedded in the image file as claimed. Claim 1 recites "in response to the editing, embedding time stamp bitmap information in the image bitmap information." Thus, the scope of claim 1 includes that the time stamp bitmap image is embedded into image bitmap. Independent claims 10 and 11 recite similar limitations of embedding time stamp bitmap information into an image bitmap.

The Examiner states in the Answer:

[T]he date information of the Kakigi reference is inherent part of the image data that is being sent to a printer. Since the Kakigi reference is converting the image into bitmap data, the date would inherently be converted since it is part of the inherent information of the image. Since the date information is inherently part of the image, the date information is inherently embedded within the converted bitmap image. While the applicant's technique may be different than Kakigi, the Kakigi reference still reads upon the claims in their current state.

Answer 13. We disagree with the Examiner's analysis. We agree with the Examiner that Kakigi teaches that the date is part of the "image inherent information." Fact 9. Kakigi teaches that the information is used as part of the sorting of the images. Facts 2 and 4. However, Kakigi does not discuss editing of the images at the printer or that the date is part of the image to be printed. Facts 8 and 9. Thus, while Kakigi does teach that the printer

generates a bitmap of the image data, Fact 7, we do not find that Kakigi teaches that the bitmap of the image may be merged with a bitmap of the date. Fact 9. Further, while Shiota does teach editing images such that the date is displayed on the printed image, Shiota does not discuss the process which accomplishes this image manipulation (i.e. Shiota does not identify if this is accomplished by embedding one bitmap into the other or if another method is used such as changing the file used to create the bitmap). Facts 10 and 14. The Examiner has presented no further evidence which would support the assertion that it is inherent that Kakigi embeds the time stamp bitmap into the image bitmap. Thus, we do not find that there is sufficient evidence to show that Kakigi in combination with Shiota would necessarily perform the function of embedding the time stamp bitmap into the image bitmap. Accordingly, the Examiner has not demonstrated that the claimed elements would have been obvious at the time of the invention and we will not sustain the rejection of claims 1, 3 through 7, 10, 11, and 13 through 16 as being unpatentable over Kakigi.

The Examiner's rejection of dependent claims 8, 9, 17, and 18 similarly rely upon the teachings of Kakigi and Shiota to teach the limitations of independent claims 1 and 11. The Examiner has not asserted that the additional teachings of Kobori remedy the deficiencies noted in the rejection of claims 1 and 11. Accordingly, we will not sustain the Examiner's rejection of claims 8, 9, 17, and 18 for the reasons discussed with respect to claims 1 and 11.

Rejections based upon 35 U.S.C. § 112, second paragraph.

Appellant's contentions have persuaded us that the Examiner erred in determining that the phrase "the print time stamp" renders claims 4 and 10 indefinite. The Examiner states on pages 4 and 5 of the Answer that there is insufficient antecedent basis in the claims for the term "the print time stamp." While we concur with the Examiner's finding that there is no antecedent basis in the claim for the term, we do not consider that this lack of antecedent basis would prevent a person skilled in the art from understanding the claim. Claim 4 is dependent upon claim 3 and recites "using the printer front panel to select the 'print time stamp' option." Claim 10 recites a similar limitation. Initially, we note the recitation "print time stamp" in the context of the claim is merely a title for an option selected through the front panel. The operation of this option is described in the second limitation of claim 4, as "converting the time stamp into bitmap information in response to selecting the 'print time stamp' option." Claim 10 recites similar limitations. We consider that one skilled in the art would understand given the terms of the claims, that "the 'print time stamp' option" is referring to selecting an option to convert the time stamp into bitmap information. Thus, we find that claims 4 and 10 are sufficiently definite and we will not sustain the Examiner's rejection under 35 U.S.C. § 112, second paragraph.

ORDER

The decision of the Examiner is reversed.

Appeal 2008-0965
Application 10/092,199

REVERSED

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